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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KIMBERLY M. HAINES, ROBERT A. LOCKWOOD, and
FRANCIS A. CZAJKA

Appeal 2015-001979
Application 13/761,896¹
Technology Center 3700

Before MICHAEL C. ASTORINO, NINA L. MEDLOCK, and
CYNTHIA L. MURPHY, *Administrative Patent Judges*.

ASTORINO, *Administrative Patent Judge*.

DECISION ON APPEAL

The Appellants appeal under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1–20. We have jurisdiction over the appeal under 35 U.S.C. § 6(b). We REVERSE.

STATEMENT OF THE CASE

Claimed Subject Matter

Claims 1, 10, and 16 are the independent claims on appeal. Claim 1, reproduced below, is illustrative of the subject matter on appeal.

¹ According to the Appellants, “[t]he real party in interest is Medline Industries, Inc.” Appeal Br. 2.

1. A surgical drape system for use in a surgical procedure, the surgical drape system comprising:
 - a surgical drape defining a fenestration of a first size sufficient to surround at least a portion of a surgical site; and
 - a removable cover of a second size larger than the first size, the cover extending across and covering the entire fenestration to thereby prevent the start of the surgical procedure prior to removal of the cover, the cover overlaying the fenestration without being attached, either directly or indirectly, to the surgical drape.

Objection and Rejections

The Specification is objected to as failing to provide proper antecedent basis for the claimed subject matter.

Claims 1–20 are rejected under (pre-AIA) 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 1–3, 10–14, and 16–19 are rejected under (pre-AIA) 35 U.S.C. § 102(b) as anticipated by Larsh (US 3,826,253, iss. July 30, 1974). .

Claims 4–9, 15, and 20 are rejected under (pre-AIA) 35 U.S.C. § 103(a) as unpatentable over Larsh, Fenwick (US 5,445, 165, iss. Aug. 29, 1995), and Carlson (US 2003/0187458 A1, pub. Oct. 2, 2003).

ANALYSIS

Objection and Written Description

Ordinarily an objection is petitionable to the Director and a rejection is appealable to the Board. When the issue of new matter presented is the subject of both an objection and a rejection, the issue is appealable. Manual of Patent Examining Procedure (MPEP) § 2163.06 II. Review of New Matter Objections and/or Rejections (9th Ed. Rev. 7, Nov. 2015)). *See also* MPEP § 608.04(c); 35 U.S.C. § 134(a); 37 C.F.R. § 1.181(a)(1). Although

the Examiner has not made a new matter rejection or objection, in this case, the objection to the Specification for lack of antecedent basis and the written description rejection turn on the same issue of whether the claimed subject matter finds adequate support in the original disclosure. As such, we will decide both the objection and the rejection.

The Examiner objects to the Specification because “the originally filed specification fails to describe the cover overlaying the fenestration without being attached, ‘either directly or indirectly’ to the surgical drape.” Final Act. 2. The Examiner rejects independent claims 1, 10, and 16 because the claims “recite that the cover overlay[s] the fenestration without being attached, ‘either directly or indirectly’.” *Id.* at 3; *see also* Ans. 6–7.

The Appellants argue that the Examiner’s rejection should be overturned because the limitation in independent claims 1, 10, and 16 that recites “the cover overlaying the fenestration without being attached, either directly or indirectly, to the surgical drape” has adequate support in the original disclosure. Appeal Br. 11–13, Reply Br. 2–4. And, for similar reasons, the Appellants argue that the Examiner’s objection to the Specification should be overturned. *See* Appeal Br. 13.

At the outset, we note that the claim limitation in dispute is a negative limitation. In other words, the “cover” is structurally limited by what it must not do, i.e., attach to the surgical drape. As such, the claim limitation requires that the cover lack an attachment means between the cover and surgical drape. A person of ordinary skill in the art would understand that any description of an attachment in the Specification — whether direct or indirect — between the cover and the surgical drape must not be part of the claimed invention.

The Specification at paragraph 37 describes that “fenestration cover 250 . . . may overlay the fenestration 220 without being attached to the surgical drape 210.” *See* Appeal Br. 3, Reply Br. 2; *see also* Spec., Fig. 5. The foregoing reasonably conveys to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. *See Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). Additionally, the Specification’s description of direct and indirect attachments, such as adhesives and hook and loop fasteners (*see, e.g.*, Spec., para. 24), between the cover and surgical drape are examples of attachment structures that must not be part of the claimed invention.

Thus, we do not sustain the Examiner’s rejection of independent claims 1, 10, and 16, and dependent claims 2–9, 11–15, and 17–20, under 35 U.S.C. § 112 (pre-AIA), first paragraph, as failing to comply with the written description requirement. We likewise do not sustain the objection to the Specification.

Anticipation by Larsh

The Examiner finds that Larsh’s release liner 7, fenestration 3, and surgical drape 1 correspond to the claimed cover, fenestration, and surgical drape, respectively. Final Act. 4. For independent claims 1, 10, and 16, to read on the Examiner’s application of Larsh’s disclosure, release liner 7 must not be attached — either directly or indirectly — to surgical drape 1. *But see* Ans. 7–8 (the Examiner, by application of Larsh’s disclosure, implies a construction of the disputed claim limitation that requires only one of either direct attachment or indirect attachment, but not both, between the

cover and the surgical drape). However, release liner 7 is attached indirectly to surgical drape 1 by a tacky surface 6 (e.g., an adhesive) of sheet 4. *See* Larsh, col. 2, ll. 49–53, col. 2, l. 65 – col. 3, l. 2, Fig. 3. For this reason, we determine that the Appellants persuasively contend that the Examiner’s finding is incorrect. Appeal Br. 14; Reply Br. 5.

Thus, we do not sustain the Examiner’s rejection of independent claims 1, 10, and 16. Additionally, the Examiner’s findings with respect to the dependent claims do not compensate for the shortcoming discussed above, so we also do not sustain the Examiner’s rejections of dependent claims 2, 3, 11–14, and 17–19.

Obviousness based on Larsh, Fenwick, and Carlson

The Examiner’s rejection based on Larsh in combination with Fenwick and Carlson relies on the same incorrect finding discussed above. *See* Final Act. 5–7. Thus, we do not sustain the Examiner’s rejection of dependent claims 4–9, 15, and 20.

DECISION

We REVERSE the Examiner’s decision objecting to the Specification and rejecting claims 1–20.

REVERSED